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CASE 4-30353B

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

EV373402476US  
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5/19/04  
Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Art Unit: 1633

GIACOBINO ET AL.

Examiner: Kaushal, S.

APPLICATION NO: 10/627,768

FILED: JULY 25, 2003

FOR: UNCOUPLING PROTEIN HOMOLOGUE:UCP3

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO NOTICE TO COMPLY

Sir:

Responsive to the Notice to Comply dated April 28, 2004, in the above-identified application, having a period for response set to expire June 28, 2004, Applicants request that the following be considered.

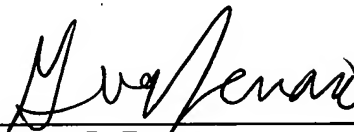
Request under 37 CFR 1.821(e)

Request is hereby made pursuant to 37 CFR 1.821(e), to use the CRF submitted in parent application 09/423,410 filed in the USPTO on November 4, 1999, now issued as US Patent No. 6,620,594 on September 16, 2003. A copy of the paper which references such submission and the Notice of Acceptance of the CRF thereof is hereby attached for the convenience of the Examiner. Reference is made to the 09/423,410 application and computer readable form submitted therein in lieu of filing a duplicate computer readable form in the instant application.

Applicants submit that the sequence listing on the CRF is identical to the paper copy of the sequence listing and contains no new matter.

In view of the foregoing, Applicant submits the Application is now in condition for allowance and respectfully requests early notice to that effect.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gregory D. Ferraro", is written over a horizontal line.

Gregory D. Ferraro  
Attorney for Applicants  
Reg. No. 36,134

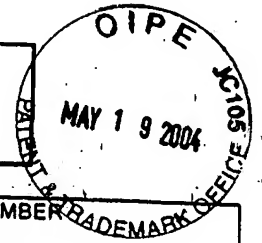
Novartis  
Corporate Intellectual Property  
One Health Plaza, Building 430  
East Hanover, NJ 07936-1080  
(862) 778-7831

Date: May 19, 2004

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

EL073188205US  
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4 November 1999  
Date of Deposit



10-1390-MOD (10-96)		U. S. Department of Commerce Patent and Trademark Office	ATTORNEY'S DOCKET NUMBER 4-30353A
<b>TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371</b>			U.S. APPLICATION NO. (If known, see 37 CFR 1.5)
INTERNATIONAL APPLICATION NO. PCT/EP 98/02645	INTERNATIONAL FILING DATE 5 May 1998 (05.05.98)	PRIORITY DATE CLAIMED 7 May 1997 (07.05.97)	
TITLE OF INVENTION UNCOUPLING PROTEIN HOMOLOGUE: UCP3			
APPLICANT(S) FOR DO/EO/US GIACOBINO ET AL.			

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☐ This express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Articles 22 and 39(1).
4. ☒ A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
5. ☒ A copy of the International Application as filed (35 U.S.C. 371(c)(2))
  - a. ☐ is transmitted herewith (required only if not transmitted by the International Bureau).
  - b. ☒ has been transmitted by the International Bureau. (See Form PCT/IB/308)
  - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☐ A translation of the International Application into English (35 U.S.C. 371(c)(2)).
7. ☒ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3)).
  - a. ☐ are transmitted herewith (required only if not transmitted by the International Bureau).
  - b. ☐ have been transmitted by the International Bureau.
  - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
  - d. ☒ have not been made and will not be made.
8. ☐ A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371 (c)(3)).
9. ☒ An executed Declaration and Power of Attorney (original or copy) (35 U.S.C. 371(c)(4)).
10. ☐ A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

Items 11. to 16. below concern document(s) or information included.

11. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. ☒ A **FIRST** preliminary amendment.  
☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
14. ☐ A substitute specification.
15. ☐ A change of power of attorney and/or address letter.
16. ☒ Other items or information: Sequence Listing and Diskette



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/627,768	07/25/2003	Jean-Paul Giacobino	4-30353B/D1

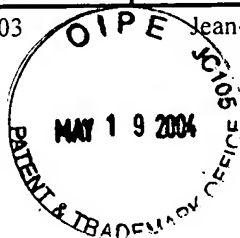
CONFIRMATION NO. 4303

WITHDRAWAL NOTICE



\*OC000000012465376\*

001095  
NOVARTIS  
CORPORATE INTELLECTUAL PROPERTY  
ONE HEALTH PLAZA 430/2  
EAST HANOVER, NJ 07936-1080



GDF

Date Mailed: 04/28/2004

WITHDRAWAL OF PREVIOUSLY SENT NOTICE

The Notice mailed on 02/23/2004 was sent in error and is hereby withdrawn. A corrected Notice is enclosed. The time period for reply runs from the mail date of the corrected Notice. We apologize for any inconvenience this caused.



*A copy of this notice MUST be returned with the reply.*

Customer Service Center  
Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY

05-20-04



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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001095  
NOVARTIS  
CORPORATE INTELLECTUAL PROPERTY  
ONE HEALTH PLAZA 430/2  
EAST HANOVER, NJ 07936-1080



CONFIRMATION NO. 4303

## FORMALITIES LETTER



\*OC000000012465836\*

Date Mailed: 04/28/2004

# NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

*Filing Date Granted*

Applicant is given **TWO MONTHS FROM THE DATE OF THIS NOTICE** within which to file the items indicated below to avoid abandonment. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

- This application does not contain a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). Applicant must provide such statement. If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000).
- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

**For questions regarding compliance to these requirements, please contact:**

- For Rules Interpretation, call (703) 308-4216
- To Purchase PatentIn Software, call (703) 306-2600
- For PatentIn Software Program Help, call (703) 306-4119 or e-mail at [patin21help@uspto.gov](mailto:patin21help@uspto.gov) or [patin3help@uspto.gov](mailto:patin3help@uspto.gov)

Replies should be mailed to: Mail Stop Missing Parts

Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

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*A copy of this notice **MUST** be returned with the reply.*



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Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

EL07318820SUS  
Express Mail Label Number

4 November 1999  
Date of Deposit



Form PTO-1390-MOD  
(REV. 10-96)

U. S. Department of Commerce Patent and Trademark Office

**TRANSMITTAL LETTER TO THE UNITED STATES  
DESIGNATED/ELECTED OFFICE (DO/EO/US)  
CONCERNING A FILING UNDER 35 U.S.C. 371**

ATTORNEY'S DOCKET NUMBER  
4-30353A

U.S. APPLICATION NO. (if known, see 37 CFR 1.5)

INTERNATIONAL APPLICATION NO.  
PCT/EP 98/02645

INTERNATIONAL FILING DATE  
5 May 1998 (05.05.98)

PRIORITY DATE CLAIMED  
7 May 1997 (07.05.97)

TITLE OF INVENTION

UNCOUPLING PROTEIN HOMOLOGUE: UCP3

APPLICANT(S) FOR DO/EO/US

GIACOBINO ET AL.

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☐ This express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Articles 22 and 39(1).
4. ☒ A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
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  - a. ☐ is transmitted herewith (required only if not transmitted by the International Bureau).
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  - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
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☐ A SECOND or SUBSEQUENT preliminary amendment.
14. ☐ A substitute specification.
15. ☐ A change of power of attorney and/or address letter.
16. ☒ Other items or information: Sequence Listing and Diskette

- ☒ Priority Document.
- ☒ Copy of the International Search Report ☐ and copies of the references cited therein.
- ☒ Other: DNA diskette

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

FORM PCT/DO/EO/903 (December 1997)

Shirley  
National Stage Processing  
Patent Specialist  
Telephone: (703) 305-3853